REMARKS

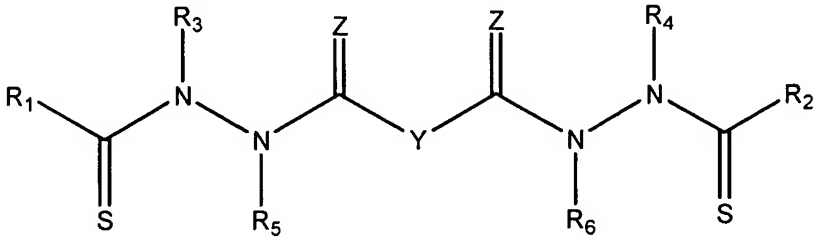
Amendment to Claim 18 and New Claims

Claim 18 has been amended to more clearly define Applicants' invention. Support for this amendment is found in the specification, for example, at page 31, line 13 through page 33, line 4. Support for new Claims 36-39 can be found, for example, at page 20, line 25 through page 22, line 13 and Examples 15-19. No new matter has been added.

Rejection of Claims 18-29 and 35 under the Nonstatutory Obviousness-Type Double Patenting

Claims 18-29 and 35 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 78-117 of U.S. Patent No. 6,800,660 (hereinafter "the '660 Patent"), claims 85-125 of U.S. Patent No. 6,762,204 (hereinafter "the '204 Patent"), claims 11, 16-20 and 24 of U.S. Patent No. 7,001,923 (hereinafter "the '923 Patent"), and claims 11, 16-20 and 24 of U.S. Patent No. 7,037,940 (hereinafter "the '940 Patent"). The Examiner stated that Claim 18, and claims dependent from claim 18, do not preclude the administration of the compound recited therein in combination with taxol itself, only analog of taxol. As such, the instant claims encompass administration of taxol itself as claimed in the '660 Patent, the '204 Patent, the '923 Patent, and the '940 Patent.

Claims 18-29 and 35 of the instant application, as amended, are directed to treatment of cancers comprising administering a compound represented by



;

alone or in combination with a second anti-cancer agent **other than taxol or a taxol analog**.

The claims of the '660 Patent, the '204 Patent, the '923 Patent, and the '940 Patent are directed to treating cancer in a subject comprising administering to the subject the compounds described therein **in combination with a taxol or a taxol analog**.

Therefore, Claims 18-29 and 35 of the instant application, as amended, do not encompass the claimed subject matter in the '660 Patent, the '204 Patent, the '923 Patent, and the '940 Patent.

Furthermore, Applicants' invention is non-obvious in light of the '660 Patent, the '204 Patent, the '923 Patent, and the '940 Patent for the reasons set forth in the Reply filed on March 6, 2006. The claims of the '660 Patent, the '204 Patent, the '923 Patent, and the '940 Patent do not teach or suggest the use of the compounds described therein **alone or in combination with a second anticancer agent other than taxol or a taxol analog** to treat cancer. Applicants have discovered and demonstrated that compound **(1)** shows similar anti-cancer activity to commonly used anti-cancer drugs Vincristin and Taxol against seven different types of leukemia cell lines (Example 19) when administered alone. Further, Applicants have discovered and demonstrated that the compounds in the instant application are effective in enhancing the anti-cancer activity of Epothilone D in treating human breast carcinoma in mice (Example 18).

The claims of '660 Patent, the '204 Patent, the '923 Patent, and the '940 Patent do not specifically disclose or otherwise suggest that the compounds could be used alone or in combination with a second anti-cancer agent other than taxol or a taxol analog to treat cancer. Moreover, the '660 Patent, the '204 Patent, the '923 Patent, and the '940 Patent do not provide the expectation that compounds would have the effectiveness as shown in Examples 18 and 19. Accordingly, one of ordinary skill in the art would have no motivation to modify the claimed subject matter of the '660 Patent, the '204 Patent, the '923 Patent, and the '940 Patent to obtain the invention of Claims 18-29 and 35, as amended, let alone a reasonable expectation that such a modification would be successful.

Rejection of Claims 1-2, 5-11, 13-19, 22-28 and 30-35 under Provisional Nonstatutory Obviousness-Type Double Patenting

Claims 1-2, 5-11, 13-19, 22-28 and 30-35 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24-29 of copending Application No. 11/157,213.

Section 804 of the Manual of the Patent Examining Procedure (hereinafter "MPEP") at page 800-17, states:

> If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.

Co-pending Application No. 11/157,213 was filed on June 20, 2005 and the instant application was filed on January 15, 2004. The instant application is the earlier filed of the two pending applications. The first Office Action for Application No. 11/157,213 has issued, which includes rejection under U.S.C. §112, first paragraph, for failing to meet the enablement requirement, and nonstatutory obviousness-type double patenting rejection. The provisional nonstatutory obviousness-type double patenting rejection would be the only rejection remaining in the instant application if the nonstatutory obviousness-type double patenting rejection over the '660 Patent, the '204 Patent, the '923 Patent, and the '940 Patent discussed above is overcome. Therefore, Applicants respectfully request the provisional nonstatutory obviousness-type double patenting be withdrawn if the Examiner withdraws the nonstatutory obviousness-type double patenting rejection over the '660 Patent, the '204 Patent, the '923 Patent, and the '940 Patent.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By _____

Steven G. Davis
Registration No. 39,652
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133
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